

Appl. No. 10/657,621
Amdt. dated Oct. 7, 2005
Reply to Office Action of July 19, 2005

REMARKS / ARGUMENTS

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

In the Claims

Claims 1-18 and 21 are presented for the Examiner's consideration. Claims 19 and 20 have been cancelled.

Claims 1 and 17 have been amended to more clearly claim the structural interactions of present invention. Support for such amendments can be found in the specification at page 7, lines 12 – 14; page 12, lines 1 – 12; page 14, lines 13 – 26; page 16, lines 1 – 9; page 18, line 25 to page 19, line 6; and FIGS. 1, 3 and 5. No new matter has been added.

Claim 21 has been added and finds support in the specification at page 7, lines 12 – 14; page 12, lines 1 – 12; page 14, lines 13 – 26; page 16, lines 1 – 9; page 18, line 25 to page 19, line 6; and FIGS. 1, 3 and 5. No new matter has been added.

Regarding Examiner's rejections

1. Rejection for obviousness by Tramontina in view of Mott et al.

By way of the Office Action mailed July 19, 2005, claims 1, 5, 8, 10, 11, 17 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Pat. No. 6,422,416 to Tramontina (hereinafter referred to as Tramontina) in view of U.S. Pat. No. 3,823,845 to Mott et al. (hereinafter referred to as Mott). This rejection is respectfully traversed to the extent that it may apply to the present claims.

Neither Tramontina nor Mott disclose all of the limitations of the claims of the present invention. Independent claims 1, 17 and 21 of the present invention each have either a member or a means for urging paper products that extends through slots in both a container and a cartridge, where the cartridge is disposed within such a container. Neither Tramontina nor Mott teaches such a structural interaction. Neither of the references teach a member, or means for urging paper products, extending into both a container and a cartridge and working in concert with a spring external to the housing of the container.

Appl. No. 10/657,621
Amdt. dated Oct. 7, 2005
Reply to Office Action of July 19, 2005

There is no teaching in either Tramontina or Mott regarding how such a container interacts with such a cartridge, nor is there any teaching regarding how such a cartridge interacts with such a container, with regard to the a spring external to the container. Additionally, there is no teaching within either Tramontina or Mott with regard to urging paper products within a cartridge by a spring external to a container in which the cartridge is disposed.

As Tramontina in view of Mott does not disclose all the limitations of independent claims 1, 17, or 19, upon which claims 5, 8, 10, and 11 depend, a *prima facie* case obviousness has not been met with regard to independent claims and to the claims depending therefrom. Accordingly, the obviousness rejection of claims 1, 5, 8, 10, 11, 17 and 19 under 35 U.S.C. §103(a) is not warranted and should be withdrawn.

2. Rejection for obviousness by Tramontina in view of Mott et al. and Tramontina et al.

By way of the Office Action mailed July 19, 2005, claims 2, 3, and 4 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over Tramontina in view of Mott and further in view of U.S. Patent Application 10/678,622 (Attorney Docket No. 19265.1) to Tramontina et al. This rejection is respectfully **traversed** to the extent that it may apply to the present claims.

U.S. Patent Application 10/678,622 was filed on October 3, 2003. As such, the application was filed after the date the present application was filed (September 3, 2003) and is therefore not a proper reference for use in an obviousness rejection under 35 U.S.C. § 103(a). Accordingly, the obviousness rejection of claims 2, 3, and 4 under 35 U.S.C. §103(a) is not warranted and should be withdrawn.

3. Rejection for obviousness by Tramontina in view of Mott et al. and Hein

By way of the Office Action mailed July 19, 2005, claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over Tramontina in view of Mott and further in view of U.S. Pat. No. 3,291,339 to Hein (hereinafter referred to as Hein). This rejection is respectfully **traversed** to the extent that it may apply to the present claims.

As described above, Tramontina in view of Mott does not disclose all the limitations of independent claims 1, upon which claims 6 and 7 depend. Hein does not remedy the

Appl. No. 10/857,621
Amdt. dated Oct. 7, 2005
Reply to Office Action of July 19, 2005

deficiencies of Tramontina and Mott as Hein also fails to disclose structural interaction limitations of the container with a cartridge. Because Hein does not teach or suggest all of the limitations of independent claims 1, a *prima facie* case obviousness has not been met with regard to claims depending therefrom. Accordingly, the obviousness rejection of claims 6 and 7 under 35 U.S.C. §103(a) is not warranted and should be withdrawn.

4. Rejection for anticipation and invention of subject matter by Tramontina et al.

By way of the Office Action mailed July 19, 2005, claims 1 - 20 stand rejected under 35 U.S.C. § 102(g) as allegedly being anticipated by U.S. Patent Application Publication No. 2004/0206768 to Tramontina et al. (hereinafter referred to as Tramontina Pub'768). This rejection is respectfully **traversed** to the extent that it may apply to the present claims.

Similarly, claims 1 - 20 stand rejected under 35 U.S.C. § 102(f) as not being invented by the applicant when compared to Tramontina Pub'768. This rejection is respectfully **traversed** to the extent that it may apply to the present claims.

Tramontina Pub'768 is an erroneous publication by the USPTO Pre-Grant Publication Office and incorrectly contains subject matter of the present application. This error is apparent upon review of the image file wrappers (as are readily available in the USPTO PAIR system) of both the present application and Patent Application No. 10/657,386 to Tramontina et al. (hereinafter referred to as Tramontina App'386). Tramontina Pub'768 was intended to be the 18-month publication of Tramontina App'386. Tramontina App'386 and present application were filed on the same day (Sept. 8, 2003) and were subsequently, sequentially published on the same day (Oct. 21, 2004). Both applications have the same Assignee.

The patent application publications for both the present application and Tramontina App'386 do not match the corresponding applications as filed (as can be seen in the image file wrappers for both cases). In fact, it appears that specifications of these two applications have been swapped in their respective publications. In particular, Tramontina Pub'768 contains all of the correct reference information on its cover page for Tramontina App'386 (including the Abstract), but the specification, drawings and claims do not match those filed for Tramontina App'386. Inexplicably, the specification, drawings and claims contained within Tramontina Pub'768 come from Provisional Application 60/463,212 to Sanders et al. The present application claims priority from Provisional Application 60/463,212.

Appl. No. 10/657,621
Amdt. dated Oct. 7, 2005
Reply to Office Action of July 19, 2005

Further investigation of the image file wrappers available through the USPTO PAIR system has revealed the publication of the present application was similarly in error. The present application was published as US2004/0206769 to Sanders et al. All of the reference information on the cover page of US2004/020679 to Sanders et al. is correct, but the abstract, specification, drawings and claims do not match those filed for the present application. Inexplicably, the abstract, specification, drawings and claims contained within US2004/020679 to Sanders et al. are as filed for Tramontina App'386.

Requests for Correction of Patent Application Publications were filed on Oct. 6, 2005 for both US2004/0206768 (Application 10/657,386) and US2004/0206769 (Application 10/657,621, i.e., the present application) to correct these gross errors.

The file wrapper for Tramontina App'386 clearly shows that the filed application of Tramontina and LeCates is different than the present application. Tramontina App'386 is also different than described and claimed in Tramontina Pub'768. Therefore, as the specification, drawings and claims of Tramontina Pub'768 are not the invention Tramontina and LeCates, and are in fact from the provisional application from which the present application claims priority, the reference should not be used against the present application. Accordingly, the rejections of claims 1-20 under 35 U.S.C. §102(f) and (g) are not warranted and should be withdrawn.

The Office Action mailed July 19, 2005, also requests that the issue of priority under 35 U.S.C. § 102(g) and possibly under 35 U.S.C. § 102(f) be resolved by the assignee stating which entity is the prior inventor of the apparent conflicting subject matter. In view of the above, Applicants state that there is no conflicting subject matter and therefore there is no issue of priority to be resolved.

5. Rejection for double patenting of the "same invention" by Tramontina et al.

By way of the Office Action mailed July 19, 2005, claims 1, 12, 17, 18, 19, and 20 stand rejected under 35 U.S.C. § 101 as allegedly being double patenting of the "same invention" type with regard to claims 1 and 2 of U.S. Patent Application Publication No. 2004/0206768 to Tramontina et al. This rejection is respectfully traversed to the extent that it may apply to the present claims.

As explained above, the content of the Tramontina Pub'768 is erroneous and does not reflect the invention or claims of the application as filed. Claims 1 and 2 of Tramontina Pub'768

Appl. No. 10/657,621
Amdt. dated Oct. 7, 2005
Reply to Office Action of July 19, 2005

are actually the claims filed with Provisional Application 60/463,212 by the inventors (Sanders and Lee) of the present application. Again, the present application claims priority to Provisional Application 60/463,212 to Sanders et al. Accordingly, the rejections of claims 1-20 under 35 U.S.C. §101 is not warranted and should be withdrawn.

All outstanding matters raised in the Office Action having been addressed, it is respectfully submitted that all of the present claims are in form for allowance. Applicants also draw attention to new claim 21, which the Applicants respectfully submit, for at least the reasons given above, is also in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-587-8640.

Respectfully submitted,

SANDERS ET AL.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Nathan Hendon, hereby certify that on October 7, 2005, this document is being sent by facsimile to the United States Patent and Trademark Office, central facsimile number for all patent application related correspondence, at 571-273-8300.

By: 

Nathan Hendon